

REMARKS

The Official Action objects to the disclosure because of identified informalities on pages 10 and 13. Please note that in connection with the language on page 10, applicant has amended the specification in accordance with the helpful recommendation provided in the Official Action.

In conjunction with the basis for this objection on page 13, line 8, for with which the Official Action notes that element 46 is not illustrated in Figure 5, applicant has amended the language of the specification to indicate that element 46 is illustrated in Figure 6.

Accordingly, reconsideration and withdrawal of this objection are respectfully requested.

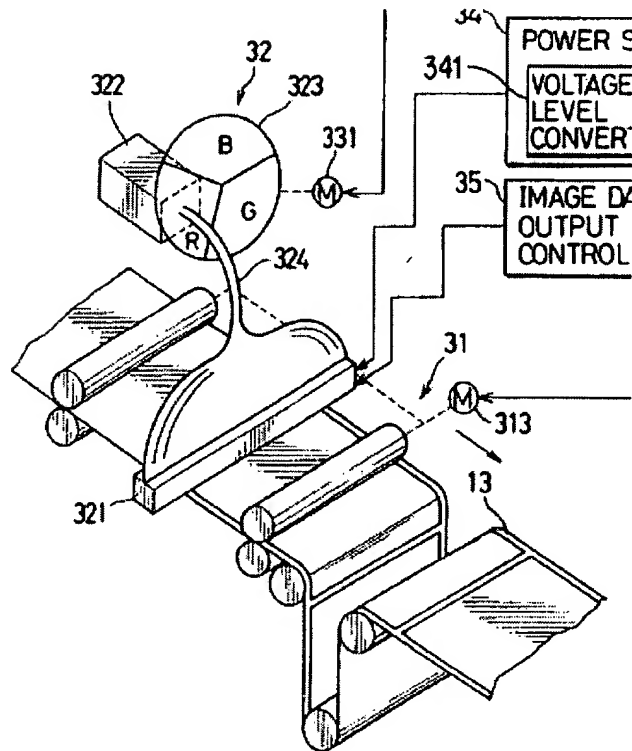
The Official Action rejects claims 1, 5, 6, and 11 under 35 USC §103(a) as being unpatentable over the admitted prior art in view of ISHIKAWA et al. Reconsideration and withdrawal of this rejection are respectfully requested for the following reasons:

The Official Action offers the admitted prior art as teaching or suggesting all the features recited in each of the rejected claims except for the characteristic of the printing

head being able to project the printing light both along the main scan direction as well as along the sub scan direction to an extent such that the printing light is projected outside of the exposure area in each dimension. Specifically, the Official Action refers to the following language in column 4 of ISHIKAWA et al:

As shown in FIG. 3, the second exposure unit 32 includes a PLZT shutter array 321 serving as an exposure head located above the photographic printing paper 13 to completely cover its width perpendicular to the direction in which the photographic printing paper 13 is advanced, a white light source unit 322 serving as the source of light to be emitted from individual light output elements of the PLZT shutter array 321... .

The Official Action also makes reference to the features illustrated in Figure 3, the pertinent portions of which are reproduced below:



At the outset, applicant notes that the illustration of Figure 3 is schematic, and should not be taken literally. Accordingly, the fact that the shutter array 321 has an apparent width greater than that of the recording medium should not be treated as a literal representation of the proportions of the actual device of ISHIKAWA et al. Moreover, even if the external boundaries of the case for the shutter array is greater than the corresponding width of the recording medium, one cannot necessarily conclude that the actual effective printing width is the same as the outer dimensions of the frame structure for the shutter array.

Additionally, applicant notes that the rejected independent claims require that the light be projected outside of the exposure area, not only in the scanning direction, but also in the sub scanning direction. In the case of the schematic illustration of Figure 3 of the applied ISHIKAWA et al. reference, the sub scanning direction would correspond to the linear dimension of the printing paper 13.

As clearly illustrated in Figure 3, the printing paper 13 is divided into individual frames, the boundaries of which are clearly indicated, it is significant that any extremely narrow band is provided between adjacent frames. Furthermore, the fundamental nature of the ISHIKAWA et al. device is that the recording medium is a continuous strip, which is cut into individual images only after the exposure has taken place. Accordingly, there is no "exposure area" as it is recited in each of the rejected independent claims in the continuous strip of the ISHIKAWA et al. photographic printing paper 13. This is because there is no limit to how far one could continuously expose along the length of the continuous strip 13. The only way that the shutter array 321 of ISHIKAWA et al. could expose beyond the exposure area in the sub scanning direction would be to expose beyond the distal ends of the photographic printing paper 13, a feature that is clearly neither taught nor suggested by such reference.

Moreover, the language of ISHIKAWA et al., and specifically the identified language relied upon by the present rejection, does not serve as teaching or suggesting of the feature under consideration. The shutter array 321 is described in the identified passage as being located above the photographic printing paper 13 to completely cover its width perpendicular to the direction in which the photographic printing paper 13 is advanced. The characteristic of "covering" such width is not the same as extending beyond such width.

Therefore, in light of the description in the text of exposing light up to, but not necessary beyond the width, as well as the lack of any exposure area limitation in the sub scanning direction, applicant respectfully suggests that the applied ISHIKAWA et al. reference fails to teach or suggest that for which it is offered, and reconsideration and withdrawal of the present rejection are respectfully requested for at least this reason.

The Official Action rejects claims 7-9 under 35 USC §03(a) as being unpatentable over the admitted prior art in view of ISHIKAWA et al. and further in view of SHINTANI. Reconsideration and withdrawal of such rejections are respectfully requested.

The Official Action also rejects claim 10 under 35 USC §103(a) as being unpatentable over the combination of references applied against claims 7-9, and further in view of FUJISAWA.

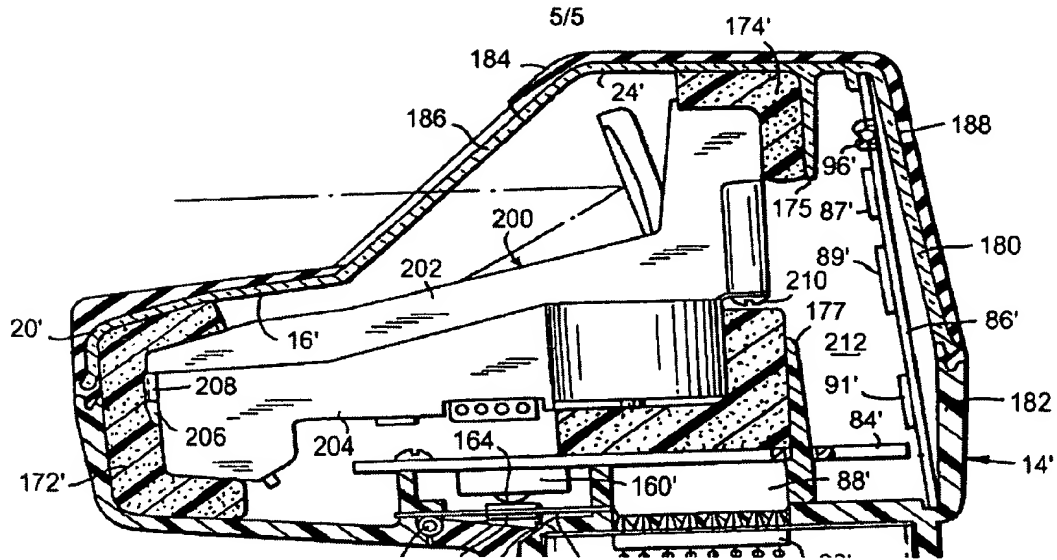
In each of these rejections, the rejected claims ultimately depend from independent claim 1, which was the subject of the rejection discussed above. As noted in conjunction with such rejection, the applied ISHIKAWA et al. reference fails to teach or suggest the characteristics related to light exposure outside of the exposure area in both the main scan and sub scan directions. The additional SHINTANI and FUJISAWA references, while possibly teaching or suggesting that for which they are specifically offered, nevertheless fail to overcome the shortcomings of ISHIKAWA et al. in terms of the features recited implicitly in claims 7-10 by virtue of their ultimate dependence from independent claim 1.

Accordingly, the overall combinations of references fail to teach or suggest the full set of features recited implicitly in these claims by virtue of their dependence, and reconsideration and withdrawal of such rejections are therefore respectfully requested.

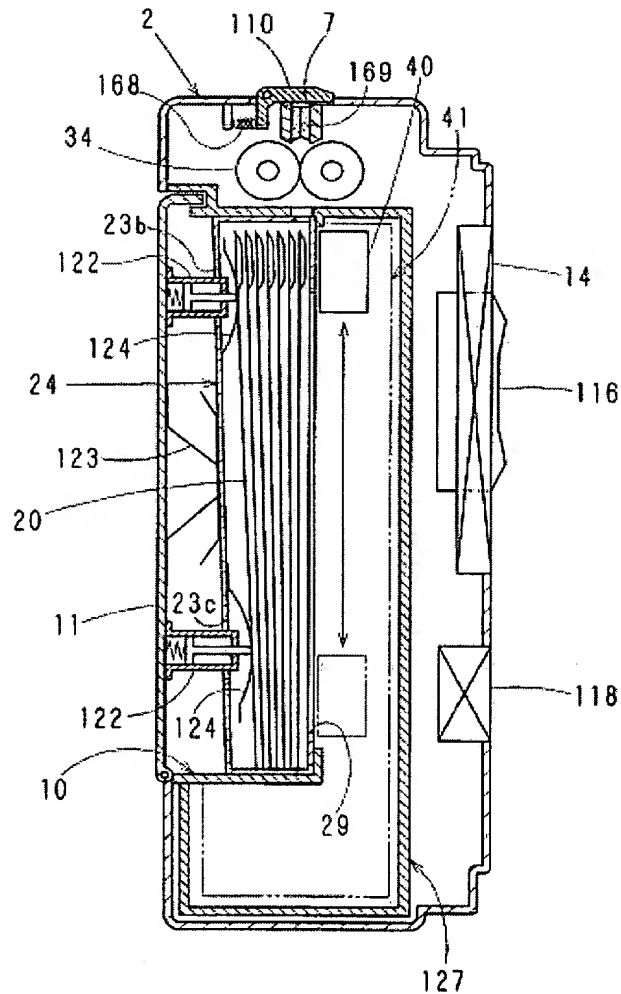
The Official Action rejects claims 13-16 under 35 USC §103 as being unpatentable over the admitted prior art in view of SWARTZ. Reconsideration and withdrawal of this rejection are respectfully requested for the following reasons:

The secondary SWARTZ reference is offered for its asserted teaching or suggestion of a light-shielding housing that covers up at least a moving range of the printing head in a light-tight fashion. The Official Action makes particular reference to Figure 14, and more particularly to the light-protective cover 184 illustrated therein. The language beginning on line 32 of column 20 of the SWARTZ et al. reference is reproduced below, followed by an excerpt from Figure 14 illustrating the transparent upper housing 180, as well as the cover 184 of light-blocking material.

Since both the outgoing light and the incoming light can pass through the transparent upper housing 180, a cover 184 of light-blocking material covers the entire exterior surface of the transparent upper housing 180, except for a window region 186 and an indicator region 188. The cover 184 is constituted on an injection-molded thermoset rubber-like material whose interior surface closely matches and conforms to the outer surface of the upper housing 180 so as to be in intimate contact with the entire exterior surface thereof and to be frictionally held thereon. The snugly fitting cover, in effect, masks all the portions of the transparent upper housing 180, other than the window region 186 and the indicator region 188, and prevents any outgoing light or incoming light from passing therethrough.



In contrast, the arrangement of the light-shielding housing 127 is illustrated below as part of present Figure 19.



The present specification describes this structure beginning on page 41, line 16. From such description and illustration, it is clear that the light-shielding housing 127 of the present invention lies inside the overall instant printer/electronic still camera body.

In stark contrast, the element 184 of SWARTZ et al. identified by the Official Action, is itself an outermost layer

of the device body, and is added as an outermost coating to a transparent layer.

In order to sharpen the distinction between the recited characteristic and the features of the SWARZ et al. device, please note that applicant has amended each of independent claims 13 and 16 to explicitly recite that the light-shielding housing is provided inside the body, as opposed to the original recitation of in the body. In this way, it is believed that there is no way that the applied SWARZ et al. reference can reasonably be construed as teaching or suggesting the recited feature. Reconsideration and withdrawal of this rejection are therefore respectfully requested.

The Official Action rejects claim 17 as being unpatentable over the admitted prior art in view of SHINTANI. The Official Action also rejects claims 18-20, each of which ultimately depends from claim 17, under 35 USC §103(a) as being unpatentable over the same set of references, and further in view of FUJISAWA. Reconsideration and withdrawal of these rejections are respectfully requested for the following reasons:

Please note that applicant has canceled claim 18, and incorporated the recitations thereof into independent claim 17. As is necessitated by such amendment and cancellation, applicant has also amended claim 19 to depend directly from claim 17.

The rejection of claims 18-20 relies on the Japanese FUJISAWA reference for its asserted teaching or suggestion of an electronic still camera comprising a device for synthesizing image data read out from the external memory with image data photographed through the imaging device, and a device for displaying a composite picture based on the synthesized image data, wherein the composite picture may be printed by driving the exposure device based on the synthesized image data.

At the outset, applicant notes that the present rejection constitutes an obviousness rejection that relies upon a combination of references, one of which is a non-English language reference, for which an English language translation of only the abstract has been provided. In this regard, the Board of Patent Appeals and Interferences has stated in a number of decisions including Ex parte Gavin, 62 USPQ2d 1680 (2001) that such a rejection is improper. Applicant notes that one of the fundamental tenets of the law that has developed under 35 USC §103 is the requirement that each reference applied under such rejection must be considered for all that it teaches. It is impossible to meet this requirement in the present case because, in the absence of an English language translation of the entire document, it is impossible to know what this reference might teach in its entirety.

Applicant notes that the cited Ex parte Gavin opinion includes, on page 1684, the following recommendation to applicants who receive such rejection:

In the event a reference is in a foreign language, if the applicant does not wish to expand the resources to obtain a translation, the applicant may wish to request the Examiner to supply a translation. If a translation is not supplied by the Examiner, the applicant may wish to consider seeking supervisory relief by way of a petition (37 CRR §1.181) to have the Examiner directed to obtain and hence supply a translation.

Further, even if the applied FUJISAWA reference were available as teaching or suggesting that for which it is offered, applicant respectfully suggests that such reference cannot reasonably be combined with the primary SHINTANI reference to teach or suggest the present invention as recited. The SHINTANI et al. reference describes a camera with an attached printing apparatus. In sharp contrast, the FUJISAWA reference apparently relates to a facsimile machine. Applicant respectfully suggests that an electronic camera and a facsimile machine are devices that are so fundamentally distinct from one another, that the combination of teachings related to the two is fundamentally improper.

In addition to the amendments described above, applicant has also added new claims 21 and 22, which depend from claims 1 and 11, respectively. Each of these claims recites that the nature of the instant film used in the recited printer and method is such that the boundaries of the photosensitive portion do not extend all the way to the outer boundaries of the physical instant film itself, so that the exposure area cannot extend all the way out to edges of the photographic film. This characteristic of the present invention is illustrated, for example, in Figures 4A and 4B. Such drawing figures illustrate, and the corresponding sections of the specification beginning on page 10 describe, that the exposure area 21 and the display area 22 on the front and rear sides of the instant film sheet, are bounded by pod 25, portion 26, and side frames 27 and 28. Accordingly, the nature of the film sheet is such that it is not photosensitive all the way out to its edges.

This lies in stark contrast to the arrangement of ISHIKAWA et al. in which the photosensitive paper 13 is photosensitive all the way out to its various edges. Accordingly, the photographic paper such as ISHIKAWA's has no "exposure area" as the term is used in the present application. This is because the effective exposure of such sheet could exist continuously along an entire length of such paper.

Please charge the fee of \$18 for the extra claim of any type added herewith, to Deposit Account No. 25-0120.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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